

REMARKS

I. Status of Claims

Claims 1-19 are pending. Claims 10-19 have been withdrawn from examination by the Examiner due to a final restriction requirement. Applicant reserves the right to prosecute the subject matter of Claims 10-19 in a divisional application.

II. Drawings

The Examiner has requested new corrected drawings in compliance with 37 CFR 1.121(d). Responsive to the Examiner's request, Applicants attach, as Appendix A, a set of drawings in compliance with 37 CFR 1.121(d).

III. Rejection of Claims 1-9 Under 35 U.S.C. §102(b)

The Examiner has rejected Claims 1 and 4 under 35 U.S.C. §102 (b), as allegedly anticipated by US Patent No. 2,711,644 ("*Myers*"). See Office Action, page 3. Specifically, the Examiner refers to Fig. 3 as anticipating the present invention.

A rejection under 35 U.S.C. §102 (b) is only proper when the claimed subject matter, in this case an apparatus suitable for measuring the gas generation potential of various liquids capable of producing gas, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPC1972); *see also* M.P.E.P. §706.02(a) ("For anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

The present invention is distinguishable from the apparatus described in *Meyers* on several levels. First, *Meyers* is directed to an apparatus to determine and measure the gas content of soils. *See Meyers*, col. 1, ll. 15-20. The present invention is directed to an apparatus suitable for measuring the gas generation potential of various liquids capable of producing gases, useful to accurately predict pressure increases in storage drums. *See Specification*, pg. 2, lines 9-20. *Meyers*' apparatus has inwardly extending baffles and an agitator which aid in the mixing and break up of the solid soil sample. *See Meyers*, col. 3, ll. 57-62. The apparatus of the present invention does not disclose inwardly extending baffles. Accordingly, for at least these reasons, the apparatus of *Meyers* fails to teach or suggest the presently claimed apparatus as is required by 35 U.S.C. §102(b) and Applicants respectively request the withdrawal of this rejection of Claims 1 and 4.

IV. Rejection of Claims 2, 3, and 5 Under 35 U.S.C. §103(a)

Claims 2, 3, and 5 have been rejected under 35 U.S.C. §103(a) as being obvious over US 2,711,644 ("*Meyers*"). See Office Action, page 4. Specifically, the Examiner takes the position that *Meyers* discloses the claimed invention except for 1) a container volume of 50 and 150 mL, 2) fabrication

of the container from 316 stainless steel or C-22 alloy, 3) use of sensing pressure in the range from 0 to 60 psig, however discovery of optimum or workable ranges is routine, the choice of materials (316 SS or C-22 Alloy), and selection of the pressure range was held as a matter of obvious design choice. See Office Action, pg. 4-5.

Applicants respectfully traverse this rejection under 35 U.S.C. §103(a) because *Meyers* fails to teach or suggest the present invention. Specifically, the apparatus of the present invention does not have inwardly extending baffles as is required by the apparatus of *Meyers*. Whether or not the size or the material of construction of the container is known in the art or not does render the present invention obvious in view of *Meyers*' disclosure. Accordingly, for at least this reason, the apparatus of *Meyers* fails to teach or suggest the presently claimed apparatus as is required by 35 U.S.C. §103(a) and Applicants respectively request the withdrawal of this rejection of Claims 2, 3, and 5.

V. Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 has been rejected under 35 U.S.C. §103(a) as being obvious over *Meyers* in view of US 6,598,457 ("*Sullivan*"). See Office Action, page 5. Specifically, the Examiner acknowledges that *Meyers* does not expressly teach a ball valve of stainless steel but relies on *Sullivan* to teach a ball valve. *Id.* Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. §103(a) for the reasons presented below.

Sullivan does not cure the deficiencies of *Meyers*. *Sullivan* discloses a method and an apparatus for measuring the amount of entrained gases in a liquid sample. The apparatus comprises conduit defining a volume and having an inlet at a lower end an outlet at an upper end. A weight measuring device is coupled to the conduit. Additionally, a control unit is coupled to the weight measuring device. See *Sullivan*, col. 3, ll. 19-48. The control unit determines a difference between the "gas-entrained" liquid flowing through the conduit and a similar volume of degassed "control" liquid.

The present invention does not require a weight measuring device nor does it have a control unit where flowing liquid is guided through. There is nothing in *Sullivan* to motivate one of ordinary skill in the art to modify the apparatus of *Meyers* in order to arrive at the claimed invention. As such, neither *Meyers* alone, nor in combination with *Sullivan*, teaches or suggests every element of the apparatus of Claim 6. Teaching or suggestion of each element of the invention is one necessary criteria for a *prima facie* case of obviousness. Accordingly, Applicants respectfully request the rejection of Claim 6 under 35 U.S.C. §103(a) be withdrawn.

VI. Rejection of Claims 7-9 Under 35 U.S.C. §103(a)

Claims 7-9 has been rejected under 35 U.S.C. §103(a) as being obvious over *Meyers* in view of US 3,578,404 ("*Walles*"). See Office Action, page 6. Specifically, the Examiner acknowledges that *Meyers* does not teach a pressure transducer or data logging software. The Examiner contends that it

would have been obvious to provide a pressure transducer and computer programmed based on the disclosure of *Walles*. *Id.* Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. §103(a) for the reasons presented below.

Walles does not cure the deficiencies of *Meyers*. *Walles* discloses a method and an apparatus for ascertaining the rate of reaction that evolves or consumes a gas; comprising a closed circuitous duct a first upstream end of which originates at a downstream portion of a reaction vessel, proceeds through valve means, pump means, and pressure sensing means, means for sensing at least one kind of influence upon the rate of a reaction in said reaction vessel, ... returning to terminate at a second, downstream end at an upstream portion of said reaction vessel which, in turn communicates with said first end. *See Walles*, Abstract.

The present invention does not require a closed circuitous duct taught by *Walles*. Additionally, during operation of *Walles*' apparatus, the interior of the duct and vessel are returned to reference pressure after each sensing increment and are subject to substantially continuous movement of gas. *Id.* The deficiencies of *Meyers*' apparatus have been previously presented. There is nothing in *Walles* to motivate one of ordinary skill in the art to modify the apparatus of *Meyers* in order to arrive at the claimed invention. As such, neither *Meyers* alone, nor in combination with *Walles*, teaches or suggests every element of the apparatus of Claim 7-9. Teaching or suggestion of each element of the invention is one necessary criteria for a *prima facie* case of obviousness. Accordingly, Applicants respectfully request the rejection of Claims 7-9 under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration of the pending claims and the reexamination of the application. The timely allowance of the pending claims is respectfully requested.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

By Patricia A. Shatynski
Patricia A. Shatynski
Reg. No. 43,109
Attorney for Applicants

MERCK & CO., INC.
P.O. Box 2000
Rahway, New Jersey 07065-0900
(732) 594-1652

Date: January 18, 2006

Attachment A



Attachment A